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JAN 13 2005

**OFFICE OF PETITIONS**

In re Application of	:	
Schumacher et al.	:	
Application No. 09/827,633	:	ON PETITION
Filed: April 6, 2001	:	
Attorney Docket No. SIE6208P0020US	:	

This is a decision on the petition under 37 CFR 1.137(a), filed on November 24, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Petition under 37 CFR 1.137(b)." This is not a final agency decision.

This application became abandoned on October 4, 2004, for failure to submit timely drawings in response to the Notice Regarding Drawings mailed on August 3, 2004, which set a two (2) month non-extendable period for reply. A Notice of Abandonment was mailed on November 12, 2004.

Petitioner states that a document entitled Submission of Formal Drawings, including substitute drawings of Figures 1-3, was sent via Federal Express Overnight mail by Joel E. Siegel, attorney of record, to his employee, Somchay Chinyavong, for hand carrying of the drawings and further consultation with the draftsperson if necessary. Petitioner states that the Federal Express package to Ms. Chinyavong indicated the correct address but did not include the suite number. The undelivered Federal Express package was returned to Mr. Siegel on October 20, 2004. Mr. Siegel states

that Federal Express did not contact him or Ms. Chinyavong, even though the package identified their correct telephone numbers, to notify them that the package would not be delivered. Mr. Siegel asserts that numerous Federal Express packages have been delivered to Ms. Chinyavong previously without the suite number. Mr. Siegel argues that the failure to file the drawings was unavoidable because he reasonably relied upon the trustworthy Federal Express Service to make a timely delivery to his employee.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) the petition fee as set forth in § 1.17(l);
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

This petition lacks item (3) above.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy

agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.<sup>1</sup>

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure or mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.<sup>2</sup>

Initially, the Office notes that Mr. Siegel assumed the risk that the drawings may not be timely filed with the USPTO when he chose to send them to his employee rather than mailing the documents directly to the USPTO. This situation could have been avoided if Mr. Siegel had used the certificate of mailing procedure specified in 37 CFR 1.8 or the Express Mail procedure specified in 37 CFR 1.10.

Additionally, Mr. Siegel states that he relied upon the trustworthy Federal Express Overnight Delivery Service to deliver the package to his employee. He did not rely on Federal Express to deliver the package to the USPTO. Moreover, Mr. Siegel admits that the Federal Express package did not indicate the suite number.

If petitioner implemented the procedures of 37 CFR 1.8 or 1.10, petitioner could have avoided the predicament which he now finds. The showing of record is that the delay in submission of the

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<sup>1</sup>In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221.F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quiqq, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

<sup>2</sup>Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

drawings was the result of Mr. Siegel's choice to mail the papers to his employee rather than directly mailing them to the USPTO. The facts and circumstances do not constitute unavoidable delay.

As petitioner has presented no showing of unavoidable delay, the petition is dismissed.

#### **ALTERNATIVE VENUE**

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(b)<sup>3</sup>, which provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

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<sup>3</sup>The provisions of 37 CFR 1.137(b) provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

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Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211.

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